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OFFICE OF PETITIONS

In re Application Of	:
Fukashiro et al.	:
Application No. 09/966,052	: DECISION ON APPLICATION
Filed: September 28, 2001	: FOR
Atty Docket No. HITACHI-0025	: PATENT TERM ADJUSTMENT
	:

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705(b)," filed July 14, 2004. Applicants requests that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from forty-eight (48) days to one hundred ninety-two (192) days.

The application for patent term adjustment is **DISMISSED**.

On June 4, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 48 days. The instant application for patent term adjustment was timely filed¹. Applicants submit that a reduction of 144 days, under 37 CFR § 1.704(c)(7), for failing to properly respond to a Notice of Non-Compliance is in error. Applicants submit that timely responses were made to the Notice of Non-Compliance, however, the United States Patent and Trademark Office wrongly continued to issue Notices of Non-Compliance. Applicants contend that the Office erred in determining that their response after non-final received July 7, 2003 and their response to Notice of Non-compliant Amendment were Non-Compliant for failing to adhere to the new Amendment format.

¹ PALM records show that the Issue Fee payment was also received July 14, 2004.

Applicants submit that the Amendment of July 7, 2003 was compliant as it was not required to be in the new Amendment format, and that the Notice of Non-Compliance was in error. Further, applicants state that as the July 28, 2003 amendment was filed before July 30, 2003, it was also not required to be in the new Amendment format.

37 C.F.R. § 1.704(c)(7) provides that:

Submission of a reply having an omission (§1.135(c))², in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed.

Petitioners' arguments have been considered. However, it has been determined that the reduction of 144 days is proper. The replies did have omissions. By Office action mailed October 29, 2003, the examiner made clear that the replies filed on July 7, 2003; July 10, 2003; and July 28, 2003 were not fully response to the Office action mailed April 4, 2003, because the "claimed subject matter is completely different." Specifically, the examiner explained that both sets of claims 1-7 were numbered the same; however, the claimed subject matter was completely different. On November 28, 2003, applicants submitted a new response, correcting the omission.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is forty-eight (48) days.

The Office acknowledges receipt of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office will forward the file to the Office of Patent Publication for issuance of the patent.

² §1.135(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

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for*

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